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Paper No. 10

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MAILED

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Watson et al. | : | |
| Application No. 09/874,770 | : | |
| Patent No. 6,443,958 | : | DECISION ON PETITION |
| Filed: June 5, 2001 | : | PURSUANT TO 37 C.F.R. |
| Issue Date: September 3, 2002 | : | § 1.378(B) |
| Attorney Docket No. 80191.00002 | : | |
| Title: UMBILICAL CORD CLAMP AND | : | |
| CUTTER | : | |

This is a decision on the petition filed on December 13, 2010, pursuant to 37 C.F.R. § 1.378(b) to reinstate the above-identified patent.

This petition pursuant to 37 C.F.R. § 1.378(b) is DISMISSED.

Background

The patent issued on September 3, 2002. The grace period for paying the 7½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on September 3, 2010, with no payment received. Accordingly, the patent expired on September 3, 2010 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;

- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Both the surcharge associated with a petition to accept the late payment of a maintenance fee as unavoidable and the 7½-year maintenance fee were submitted on November 19, 2010. This petition was received on December 13, 2010, along with the notation "Resubmission - fees already sent + received."

Petitioner has not established that this petition was originally filed prior to December 13, 2010, and the official file does not contain any indication that the petition was originally submitted prior to December 13, 2010.¹ Moreover, it does not appear that a statement of facts was included with this petition: the submission of December 13, 2010 consists of two copies of the facsimile cover sheet (each is dated November 19, 2010, and indicates that six total pages were included in the transmittal) and a three-page petition. Perhaps the remaining two pages consisted of a statement of facts? If this is the case, it does not appear that these two pages were included with the submission of December 13, 2010.

Petitioner has met the first and second requirements of Rule 1.378(b). The third requirement of Rule 1.378(b) will be discussed below.

The standard

35 U.S.C. § 41(c)(1) states, *in pertinent part*:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay² is shown to the satisfaction of the Director to have been unavoidable.

¹ It is noted that the petition contains a certificate of mailing dated November 13, 2010, however it does not appear that a statement pursuant to 37 C.F.R. § 1.8(b)(3) was included with the submission of December 13, 2010.

² This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.³

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."⁴

The burden of showing the cause of the delay is on the person seeking to revive the application.⁵

Application of the standard to the current facts and circumstances

It does not appear that Petitioner has provided an explanation of the delay. It follows that the standard for acceptance of a late payment of the maintenance fee and surcharge has not been satisfied.

The period for paying the 7½-year maintenance fee without the surcharge extended from September 3, 2009 to March 3, 2010 and for paying with the surcharge from March 4, 2010 to September 3, 2010. Thus, the delay in paying the 7½-year maintenance fee extended from September 3, 2010 at midnight to the filing of this petition on December 13, 2010.

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

⁴ Haines v. Quigg, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

⁵ Id.

As set forth above, it does not appear that a statement of facts was submitted concurrently with this petition. It follows that the record does not contain a showing that the delay was unavoidable, as will now be pointed out.

First, the record does not contain an enumeration of the steps taken to ensure timely payment of the maintenance fee. An adequate showing that the delay in payment of the maintenance fees at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fees, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b).

Second, the record does not contain an indication of the date and the manner in which Patentee became aware of the expiration of the patent.

Third, the record does not contain a description of the steps taken to file the petition promptly.

Conclusion

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in 37 C.F.R. § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that Petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner must provide documentation and address the deficiencies noted above. If on request for reconsideration, the delayed payment of the maintenance fees is not accepted, then the maintenance fees are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.378(e)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,⁶ hand-delivery,⁷ or facsimile.⁸ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.⁹

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Inquiries pertaining to the submission of maintenance fees should be directed to the Maintenance Fee branch at 571-272-6500.

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

⁶ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁷ Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

⁸ (571) 273-8300 - please note this is a central facsimile number.

⁹ <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>